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Technology Center 2100

In re Application of: Frederick S. Dunlap et al.)
Application No.: 09/477,099)
Filed: January 4, 2000)
For: SYSTEM AND METHOD FOR)
FORCING AN SRAM INTO A)
KNOWN STATE DURING POWER-)
UP)

**DECISION ON PETITION
UNDER 37 CFR §1.181 FOR
SUPERVISORY REVIEW**

This is a decision on the petition under 37 CFR 1.181 filed May 16, 2005 requesting entry of the Amendment under 37 C.F.R. 1.116 filed February 8, 2005.

The petition is **DISMISSED**.

CASE HISTORY

This application was filed on January 4, 2000, with originally presented claims 1-22.

A first Office action rejecting claims 1-22 was mailed to Applicant's representative on February 23, 2004. Applicant filed a response on May 28, 2004 which included amendments to the specification, drawings, and claim 11, cancellation of claims 21-22, and arguments traversing the rejections. An Office action, finally rejecting the pending claims 1-20 was mailed on December 9, 2004.

In a paper filed February 14, 2005, Applicant submitted an amendment to the claims rewriting claims 1 and 11 to incorporate claims 10 and 20 respectively, cancelling claims 10 and 20 and adding claims 23-26, and presented arguments traversing the rejections of record. The Examiner responded with an Advisory action (mail date March 7, 2005) refusing entry of the amendments and did not withdraw the finality of the previous Office action.

Applicant filed a petition under 37 CFR 1.181 on May 16, 2005 contending (a) that the Examiner erred in refusing entry of the amendment filed on February 14, 2005 because it merely incorporates claims 10 and 20 into claims 1 and 11 respectively and that (b) that there is no indication in the Advisory action whether the arguments presented were considered on the merits.

In partial response to this petition, on August 31 2005, the Examiner issued a new Advisory addressing the arguments on the merits and indicating that the amendment after final would not be entered.

OPINION

Petitioner argues that "Although the proposed amendments to claims 1 and 11 may have the effect of changing the scope of other claims ...the proposed amendments narrowed the scope of all pending claims and therefore present the rejected claims in better form for appeal by reducing and simplifying issues for appeal".

The relevant section of the MPEP concerning entry of amendments after a final rejection is MPEP § 714.13 which states:

ENTRY NOT A MATTER OF RIGHT¹

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way *requires only a cursory review by the examiner*, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection.

As the new advisory points out, Applicant has presented new claims without cancellation of at least an equal number of claims. On this basis alone the amendment is properly refused entry. Since amendments are not entered in part, the rewritten claims 1 and 11 would not be entered.

Furthermore, the Examiner has determined that the arguments as to patentability of claims 10 and 20 do not (in the Examiner's opinion) overcome the rejection of record. Therefore, entry of the amendments to claims 1 and 11 is not appropriate as it would require the Examiner to review the remaining claims for compliance with 45 U.S.C. §112 and as to the necessity of citing new art for the newly narrowed dependent claims. This analysis requires more than cursory review.

The examiner's refusal to enter the proposed amendment filed is correct and consistent with Office policy and practice. Accordingly, the Petition to compel the examiner to enter the amendment is **DISMISSED**.

The application file is being forwarded to Central Files to await a response to the Notice of Non-Compliant Appeal Brief of mail date August 31, 2005.

Any request for reconsideration of this decision must be filed within 2 months.

¹ Although this section of the MPEP refers to 37 CFR §1.116 as it existed prior to the latest revision, the result is unaffected by the new version

Decision on Petition

Any inquiries with respect to this decision may be addressed to the undersigned at the number provided below.

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